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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte HIDENARI TANAKA, HIROSHI MURAKAMI,  
KO HAYASHI, YOSHIHARU YAMADA, KAZUTOSHI TAKASE,  
TETSUKAZU NAKAMURA, and AKIRA ISHIHARA

Appeal 2007-2731  
Application 09/209,454  
Technology Center 3600

Decided: January 18, 2008

21Before TERRY J. OWENS, MURRIEL E. CRAWFORD, and  
22ANTON W. FETTING, Administrative Patent Judges.  
23FETTING, Administrative Patent Judge.

## DECISION ON APPEAL

## STATEMENT OF CASE

26 Hidenari Tanaka, Hiroshi Murakami, Tatuhiko Hayashi, Yoshiharu Yamada,  
27 Kazutoshi Takase, Tetsukazu Nakamura, and Akira Ishihara (Appellants) seek  
28 review under 35 U.S.C. § 134 of a final rejection of claims 17-22, the only claims  
29 pending in the application on appeal.

<sup>30</sup> We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

31  
32 We AFFIRM

1 The Appellants invented a system for selling contact lenses using information  
2 processing apparatus connected through a communication network. (Specification  
3 31:4-6).

4 An understanding of the invention can be derived from a reading of exemplary  
5 claim 17, which is reproduced below [bracketed matter and some paragraphing  
6 added].

7 17. A method of selling prescription contact lenses comprising:

8 [1] transferring contact lens customer

9 identification,

10 address, and

11 diagnostic data

12 pertaining to a respective contact lens customer

13 from a plurality of second group information processing

14 apparatus located at respective facilities of contact lens  
15 prescribers,

16 the plurality of second group information processing  
17 apparatus being connected through a communication  
18 network to a first group information processing apparatus  
19 located at a facility of a contact lens seller,

20 to the first group information processing apparatus through the  
21 communication network;

22 [2] assigning a registration number to the customer and

23 storing the registration number assigned

24 in relationship with the customer identification and diagnostic data  
25 transferred to the contact lens seller;

26 [3] providing

27 the registration number assigned and

28 selling agent data

1 for a selling agent closest in geographical relation to the  
2 customer based on the contact lens customer address  
3 data,  
4 from the contact lens seller to the contact lens customer,  
5 through the communication network;  
6 [4] delivering a contact lens from the selling agent to the contact lens  
7 customer;  
8 [5] transferring delivery data from the selling agent to the contact lens  
9 seller through the communication network;  
10 [6] writing,  
11 through both the first group information processing apparatus  
12 and  
13 the plurality of second group information processing apparatus,  
14 on respective portable recording media for each contact lens  
15 customer,  
16 data, including the corresponding registration number, and  
17 issuing the corresponding portable recording medium to the  
18 respective customer,  
19 so the contact-lens customer can select any contact lens  
20 prescriber, and  
21 change between any contact lens prescriber,  
22 having access to one of the second group information  
23 processing apparatus and the communication network  
24 without changing the contact lens seller;  
25 [7] determining an exchange time for exchanging the contact lens,  
26 based upon date of issuance of the contact lens and  
27 characteristics of the contact lens,  
28 by the first group information processing apparatus of the  
29 contact lens seller,  
30 using data recorded on the portable recording medium of the  
31 corresponding contact lens customer to whom a contact lens has  
32 been issued by the contact lens seller through the selling agent;  
33 and

[8] notifying a contact lens customer to whom a contact lens was issued of the exchange time.

3 This appeal arises from the Examiner's Final Rejection, mailed October 24, 42004. The Appellants filed an Appeal Brief in support of the appeal on March 14, 52005. An Examiner's Answer to the Appeal Brief was mailed on September 22, 62006. A Reply Brief was filed on August 4, 2005.

7 PRIOR ART

8 The Examiner relies upon the following prior art:

Pauly	US 4,958,280	Sep. 18, 1990
Dawson, Jr.	US 5,623,242	Apr. 22, 1997
Eberhardt	US 5,659, 741	Aug. 19, 1997
Fay	US 5,983,201	Nov. 9, 1999

<sup>9</sup>Thomas M. Steltzer, "Cashing in on quicker delivery times," Chilton's Distribution, v.90, n.6, p. 34(3), June 1991.

11 REJECTIONS

12 Claims 17, 19, and 21 stand rejected under 35 U.S.C. § 103(a) as unpatentable  
13 over Pauly, Fay, and Eberhardt.

14 Claim 18 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Pauly,  
15 Fav, Eberhardt, and Dawson.

16 Claims 20 and 22 stand rejected under 35 U.S.C. § 103(a) as unpatentable over  
17 Pauly, Fav, Eberhardt, and Steltzer.

18 ISSUES

19 The issues pertinent to this appeal are:

1     • Whether the Appellants have sustained their burden of showing that the  
2       Examiner erred in rejecting claims 17, 19, and 21 under 35 U.S.C. § 103(a)  
3       as unpatentable over Pauly, Fay, and Eberhardt.

4     • Whether the Appellants have sustained their burden of showing that the  
5       Examiner erred in rejecting claim 18 under 35 U.S.C. § 103(a) as  
6       unpatentable over Pauly, Fay, Eberhardt, and Dawson.

7     • Whether the Appellants have sustained their burden of showing that the  
8       Examiner erred in rejecting claims 20 and 22 under 35 U.S.C. § 103(a) as  
9       unpatentable over Pauly, Fay, Eberhardt, and Steltzer.

10    The pertinent issues turn on whether Pauly or Fay would have suggested  
11 delivering contact lenses from a selling agent separate from the original prescriber.

#### 12                   FACTS PERTINENT TO THE ISSUES

13    The following enumerated Findings of Fact (FF) are believed to be supported  
14 by a preponderance of the evidence.

##### 15    Pauly

- 16       1. Pauly is directed toward alternative ordering methods for eye care  
17       professionals. The methods include automated order entry through  
18       personal computers at the professional's office location, communicating  
19       through data links with central computers at the supplier, and direct  
20       telephone calls.
- 21       2. Pauly uses the term ‘doctor’ to refer to a prescribing party, which may  
22       be an ophthalmologist, optometrist, an optician, or a commercial entity  
23       involved in the business of contact lens prescriptions (Pauly 3:44-50).

1       3. There may be many such prescribing parties connected to Pauly's  
2           system by personal computers (Pauly 4:51-54)

3       Fay

4       4. Fay is directed toward the field of eyeglasses. Fay's device assists in  
5           fitting frames for eyeglasses to a customer and displaying to the

6           customer how the customer would appear wearing the fitted eyeglass  
7           frames (Fay 1:9-14).

8       5. Fay's frames may be fitted with prescription or plain lenses (Fay 2:59-  
9           60).

10       6. Fay's device may be located on the premises of an optician or an  
11           optometrist (Fay 5:29-31).

12       7. Fay's customer can direct that the frames be obtained via a selected  
13           optical retail store. Fay then presents a database of optical retail  
14           locations to the customer. Once the order is complete, the relevant order  
15           information concerning the frame and prescriptive lens information, and  
16           customer information is sent to the selected optical retail location for  
17           processing of the order. The customer can then complete the transaction  
18           at the selected optical retail location.

1 Eberhardt

2 8. Eberhardt is directed toward storing medical history on a storage device  
3 that a patient can carry on its person for aggregating vast amounts of  
4 medical history (Eberhardt 1:9-60).

5 PRINCIPLES OF LAW

6Claim Construction

7 During examination of a patent application, pending claims are given  
8their broadest reasonable construction consistent with the specification. *In*  
9*re Prater* , 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci.*  
10*Tech Ctr.*, 367 F.3d 1359, 1364, (Fed. Cir. 2004).

11 Limitations appearing in the Specification but not recited in the claim are not  
12read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed.  
13Cir. 2003) (claims must be interpreted “in view of the specification” without  
14importing limitations from the specification into the claims unnecessarily)

15 Although a patent applicant is entitled to be his or her own lexicographer of  
16patent claim terms, in ex parte prosecution it must be within limits. *In re Corr*, 347  
17F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions  
18in the Specification with sufficient clarity to provide a person of ordinary skill in  
19the art with clear and precise notice of the meaning that is to be construed. See  
20also *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994)(although an inventor is  
21free to define the specific terms used to describe the invention, this must be done  
22with reasonable clarity, deliberateness, and precision; where an inventor chooses to  
23give terms uncommon meanings, the inventor must set out any uncommon

1definition in some manner within the patent disclosure so as to give one of  
2ordinary skill in the art notice of the change).

3Obviousness

4 A claimed invention is unpatentable if the differences between it and the  
5prior art are “such that the subject matter as a whole would have been obvious at  
6the time the invention was made to a person having ordinary skill in the art.” 35  
7U.S.C. § 103(a) (2000); *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007);  
8*Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

9 In Graham, the Court held that that the obviousness analysis is bottomed on  
10several basic factual inquiries: “[1] the scope and content of the prior art are to be  
11determined; [2] differences between the prior art and the claims at issue are to be  
12ascertained; and [3] the level of ordinary skill in the pertinent art resolved.” 383  
13U.S. at 17. See also *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. at 1734. “The  
14combination of familiar elements according to known methods is likely to be  
15obvious when it does no more than yield predictable results.” *KSR*, at 1739.

16 “When a work is available in one field of endeavor, design incentives and  
17other market forces can prompt variations of it, either in the same field or [in] a  
18different one. If a person of ordinary skill in the art can implement a predictable  
19variation, § 103 likely bars its patentability.” *Id.* at 1740.

20 “For the same reason, if a technique has been used to improve one device,  
21and a person of ordinary skill in the art would recognize that it would improve  
22similar devices in the same way, using the technique is obvious unless its actual  
23application is beyond his or her skill.” *Id.*

1       “Under the correct analysis, any need or problem known in the field of  
2 endeavor at the time of invention and addressed by the patent can provide a reason  
3 for combining the elements in the manner claimed.” *Id.* at 1742.

## 4 Automation of a Known Process

5 It is generally obvious to automate a known manual procedure or mechanical  
6device. Our reviewing court stated in *Leapfrog Enterprises, Inc. v. Fisher-Price,*  
7*Inc.*, 485 F.3d 1157 (Fed. Cir. 2007) that one of ordinary skill in the art would have  
8found it obvious to combine an old electromechanical device with electronic  
9circuitry “to update it using modern electronic components in order to gain the  
10commonly understood benefits of such adaptation, such as decreased size,  
11increased reliability, simplified operation, and reduced cost. . . . The combination  
12is thus the adaptation of an old idea or invention . . . using newer technology that is  
13commonly available and understood in the art.” *Id* at 1163.

14 ANALYSIS

15 *Claims 17, 19, and 21 rejected under 35 U.S.C. § 103(a) as unpatentable over*  
16 *Pauly, Fav, and Eberhardt.*

17 The Appellants argue claims 17 and 21 as a group.

18 Accordingly, we select claim 17 as representative of the group.  
1937 C.F.R. § 41.37(c)(1)(vii)(2006).

20 The Examiner found that Pauly describes all of the contact lens data and  
21 transactions of claim 17, that Fay is evidence that a purchaser of prescription lens  
22 might prefer to accept delivery from a retail optical shop to show the sales agent  
23 activities of claim 17, and that Eberhardt described a portable recording medium as  
24 cited in claim 17 (Answer 3-8).

1 The Appellants contend that (1) Pauly doesn't show the portable recording  
2medium in claim 17 (Br. 6: Top ¶ and first half of first full ¶); (2) claim 17  
3establishes loyalty between the customer and seller, whereas Pauly establishes  
4loyalty between customer and prescriber (Br. 6: Bottom half of first full ¶ and  
5bottom ¶); (3) claim 17 requires that the nearest selling agent deliver the lenses,  
6whereas Pauly does not (Br. 7: First full ¶); (4) Fay is inapplicable because Fay  
7describes selling eyeglass frames and not contact lenses, eliminating a need for an  
8optician (Br. 7: Second full ¶); (5) one of ordinary skill would not consult Fay  
9because Fay does not relate to contact lenses and Fay's device is for showing a  
10customer's facial appearance which contact lenses do not alter (Br. 7: Third full ¶ -  
118 First full ¶); and (6) neither Pauly nor Fay describe a portable medium (Br. 8:  
12Second full ¶).

13Appellants' arguments (1) and (6) that neither Pauly nor Fay show the portable  
14recording medium in claim 17.

15 The Appellants' argument overlooks Eberhardt as applied prior art. We find,  
16as the Examiner found, that Eberhardt describes providing a portable recording  
17medium for holding patient data (FF ). The Appellants acknowledge that  
18Eberhardt describes the portable medium, but their only argument as to Eberhardt  
19is that even with Eberhardt, there is no basis for modifying Pauly with Fay (Br.  
208:Second full ¶). We find the argument that neither Pauly nor Fay show that which  
21Eberhardt is applied to describe to be unpersuasive in view of Eberhardt's  
22uncontested description.

23Appellants' argument (2) that claim 17 establishes loyalty between the customer  
24and seller, whereas Pauly establishes loyalty between customer and prescriber.

25 The Appellants argue that the customer establishing loyalty with the selling  
26agent in claim 17 is a feature unrecognized by the Examiner (Br. 6:First full ¶).

1 We find that this argument is not commensurate with the scope of claim 17,  
2 which is silent as to loyalty. To the extent the Appellants are implying that such  
3 loyalty is a secondary consideration for evidence of non-obviousness, the  
4 Appellants have not made a connection between such loyalty and any evidence of  
5 non-obviousness such as an unexpected benefit of the claimed invention.

6 Appellants' argument (3) that claim 17 requires that the nearest selling agent  
7 deliver the lenses, whereas Pauly does not.

8 The Appellants argue that it is the party the customer goes to for picking up the  
9 lenses from that establishes the loyalty in the prior argument, and claim 17 requires  
10 this be a selling agent, while Pauly describes this party as the prescriber (Br.  
116:Second full ¶ - 7:First full ¶).

12 Again, claim 17 is silent as to loyalty. Claim 17 does recite that it is the selling  
13 agent that delivers the lenses to the customer in step [4]. While, as the Appellants  
14 argue, it is Pauly's prescriber who delivers the lenses, Pauly describes the  
15 prescriber as an ophthalmologist, optometrist, optician, or a commercial entity  
16 involved in contact lens prescriptions (FF ). Pauly also shows that multiple such  
17 prescribers are connected to its system (FF ). Thus, Pauly does not preclude  
18 having one prescriber initially and another for delivery.

19 Fay suggests that a prescription lens patient may desire to have just such a  
20 separation between the initial prescriber and the delivery agent; common sense  
21 suggests this would be for subsequent convenience in delivery. Fay describes its  
22 device as being possibly located at a prescriber, such as an optician or optometrist  
23 (FF ). Common sense again suggests this is because the lenses in Fay's eyeglass  
24 frames may be prescription lenses (FF ). Fay describes an alternate delivery  
25 location from where its device was used, such as an optical retail location (FF ).

1     Fay describes its device as providing a list of locations of such optical retail  
2locations, suggesting that choice of location would be a reason the customer would  
3prefer such a location (FF ). Such a list, by its encompassing scope, would include  
4within it the location closest in geographical relation to the customer as recited in  
5claim step [3]. One of ordinary skill, and even common sense, would recognize  
6that the most likely such retail location a customer would select, based on a  
7purchasing convenience selection criterion, would be that location closest to the  
8customer. “Often, it will be necessary for a court to look to . . . the effects of  
9demands known to the design community or present in the marketplace; and the  
10background knowledge possessed by a person having ordinary skill in the art, all in  
11order to determine whether there was an apparent reason to combine the known  
12elements in the fashion claimed by the patent at issue.” KSR, id. at 1740-41.

13    Thus, although Pauly does not describe delivery from a selling agent, Fay  
14describes delivery of optical lenses from a selling agent in the form of an optical  
15retail location separate from the prescriber, and suggests that an optical lens  
16purchaser would desire to select such a location as its sales agent separate from the  
17prescriber. Common sense suggests this would be for the sake of convenience and  
18therefore the closest such location would likely be selected as the most convenient.  
19Therefore, we find this argument unpersuasive.

20Appellants’ argument (4) that Fay is inapplicable because Fay describes selling  
21eyeglass frames and not contact lenses, eliminating a need for an optician.

22    The Appellants appear to be arguing that Fay needs no optician (Br. 7:Second  
23full ¶). The Appellants overlook Fay’s description of the possible location for its  
24device as being at just such an optician, or even optometrist (FF ). This coincides  
25with Pauly’s description of its prescribers (FF ). For that matter, Fay’s retail  
26optical location may coincide with Pauly’s commercial entity involved in the

1business of contact lens prescriptions (FF ). Since all of these locations may be  
2connected to Pauly's system (FF ), and Fay suggests that a customer may choose a  
3sales agent for delivery separate from a prescriber (FF ), Fay provides the  
4motivation for allowing a customer to select a selling agent tied in to Pauly's  
5system separate from Pauly's prescriber. Therefore, we find this argument  
6unpersuasive.

7Appellants' argument (5) that one of ordinary skill would not consult Fay because  
8Fay does not relate to contact lenses and Fay's device is for showing a customer's  
9facial appearance which contact lenses do not alter.

10 We take this argument to mean that one of ordinary skill would not combine  
11Pauly and Fay (Br. 7:Third full ¶ - 8:First full ¶). This argument is echoed by the  
12Appellants subsequently in its argument concerning Eberhardt's portable media we  
13analyzed, *supra*.

14 As we noted above, market forces may dictate design. See KSR, *id.* Fay  
15presents evidence of marketplace demand by customers of prescriptive lenses for  
16delivery of lenses by a party separate from the original prescriber (FF ). It is not  
17necessary that one of ordinary skill would have looked to incorporating Fay's  
18machine into Pauly's design for Fay's evidence of this market demand to be  
19pertinent to Pauly. It is sufficient that Fay is descriptive of at least part of the  
20market that Pauly must address, which the commonality of the optometrist and  
21optician locations in both Pauly and Fay show to be the case. Thus, we find that  
22Fay is at least probative of the market demand that users of Pauly's system would  
23face and therefore the Appellants' arguments are unpersuasive.

24 The Appellants separately argue claim 19. Claim 19 recites offering new  
25contact lenses to the contact lens customer in exchange for old contact lenses at  
26irregular times, upon any of loss of transparency of the contact lenses, breakage of

1the contact lenses, and scratching or soiling of the contact lenses, and a monthly  
2payment by the contact lens customer.

3 The Examiner found that a customer would replace contact lenses with Pauly's  
4process when lenses were broken or scratched and this would occur irregularly  
5(Answer 8-9). The Appellants argue the Examiner has provided no evidence (Br.  
68:Last ¶).

7 Although it appears the Appellants attempted to draft an insurance type  
8transaction in claim 19, it is actually broader than that. As the Examiner found, it  
9only requires that the seller offer replacements for broken, scratched, transparency  
10lost, or soiled lens for monthly payment. The claim makes no restriction on  
11whether the payment is prospective or retrospective with respect to the loss. As the  
12Examiner found, subsequent payment would correspond to simply purchasing  
13another lens or set of lenses. We find that monthly payments are a common cycle  
14of paying for relatively costly items, such as contact lenses. Thus, we find the  
15Appellants argument unpersuasive.

16 The Appellants have not sustained their burden of showing that the Examiner  
17erred in rejecting claims 17, 19, and 21 under 35 U.S.C. § 103(a) as unpatentable  
18over Pauly, Fay, and Eberhardt.

19 *Claim 18 rejected under 35 U.S.C. § 103(a) as unpatentable over Pauly, Fay,  
20 Eberhardt, and Dawson.*

21 The Appellants have relied on their arguments regarding claim 17 and have not  
22separately argued the limitations of claim 18. We therefore find the Appellants  
23have not sustained their burden of showing that the Examiner erred in rejecting  
24claim 18 under 35 U.S.C. § 103(a) as unpatentable over Pauly, Fay, Eberhardt, and  
25Dawson for the same reasons we found *supra*.

3 The Appellants have relied on their arguments regarding claim 17 and have not  
4separately argued the limitations of claims 20 and 22. We therefore find the  
5Appellants have not sustained their burden of showing that the Examiner erred in  
6rejecting claim claims 20 and 22 under 35 U.S.C. § 103(a) as unpatentable over  
7Pauly, Fay, Eberhardt, and Steltzer for the same reasons we found *supra*.

## 8 CONCLUSIONS OF LAW

9 The Appellants have not sustained their burden of showing that the Examiner  
10erred in rejecting claims 17-22 under 35 U.S.C. § 103(a) as unpatentable over the  
11prior art.

12 On this record, the Appellants are not entitled to a patent containing claims 17-1322.

## 14 REMARKS

15 Should the Appellants amend claim 19 to more closely recite a contact lens  
16insurance transaction, the Examiner should consider the notoriety of such  
17insurance and the relevance of insurance companies, such as RLI Corp, that began  
18offering such insurance in the early 1960's.<sup>1</sup>

50<sup>1</sup><http://my.rlicorp.com/about/history.asp>

1 DECISION

2 To summarize, our decision is as follows:

3 • The rejection of claims 17, 19, and 21 under 35 U.S.C. § 103(a) as  
4 unpatentable over Pauly, Fay, and Eberhardt is sustained.

5 • The rejection of claim 18 under 35 U.S.C. § 103(a) as unpatentable over  
6 Pauly, Fay, Eberhardt, and Dawson is sustained.

7 • The rejection of claims 20 and 22 under 35 U.S.C. § 103(a) as unpatentable over  
8 Pauly, Fay, Eberhardt, and Steltzer is sustained.

9 No time period for taking any subsequent action in connection with this appeal  
10may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

11

12 AFFIRMED

13

14  
15  
16jlb

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21